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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Profiles Corporation

Serial No. 75/202,389

Ralph H. Lane of Pattishall, McAuliffe, Newbury, Hilliard & Geraldson for Profiles Corporation.

Irene D. Williams, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Simms, Hohein and Bottorff, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Profiles Corporation has filed an application to register the mark "INSIDE THE SAT" for "videotapes, video discs, computer programs and CD-ROMS in the field of educational test preparation, namely, in the field of preparation for taking scholastic aptitude tests and scholastic assessment tests".¹

¹ Ser. No. 75/202,389, filed on November 22, 1996, which alleges a bona fide intention to use the mark in commerce. The term "SAT" has been voluntarily disclaimed.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "SAT," which is registered for "printed tests and test booklets,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Preliminarily, we note that in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity of the goods and the similarity or dissimilarity of the marks. See, e.g., *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).³ As to the respective goods, applicant acknowledges in its main brief that "the same users will probably use applicant's test preparation materials and the [registrant's] SAT [test] itself." Applicant, however, argues among other things that "users of applicant's test preparation materials will readily distinguish between preparatory materials and the actual admission-

² Reg. No. 1,067,665, issued on March 15, 1976, which sets forth dates of first use of May 1947; first renewal.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

determining examination" offered by registrant. In particular, applicant notes that its "test preparation materials and the cited registrant's tests are not used conjointly in the sense that bread and cheese are used together (simultaneously)" and stresses that its products, "being goods in the field of educational test preparation, are not educational tests themselves." Applicant consequently insists that because "there is no overlap or component relationship between the respective goods," there is no likelihood of confusion.

However, as stated in *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984), "the question to be determined herein is not whether the goods are likely to be confused but rather whether there is a likelihood of confusion as to the source of the goods because of the marks used thereon." Moreover, as correctly pointed out by the Examining Attorney, it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem

Corp., 199 USPQ 590, 595-96 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In the present case, it is obvious that applicant's videotapes, video discs, computer programs and CD-ROMs in the field of preparation for taking scholastic aptitude tests and scholastic assessment tests would be of interest only to those interested in preparing for, or who are considering whether to take, the kinds of scholastic aptitude and/or assessment tests offered by registrant. Absent such tests, there would not even be a market for applicant's goods. The Examining Attorney, furthermore, has in any event supported her contention that applicant's test preparation materials are closely related to registrant's tests by making of record several use-based third-party registrations for marks which, in each instance, are registered for videocassettes, computer programs and CD-ROMs for use in preparing for standardized tests or other educational programs, on the one hand, and printed tests, testing sheets and/or booklets, on the other. Although such registrations admittedly are not evidence that the marks shown therein are in use or that the public is familiar with them, they still have some probative value to the extent that they serve to suggest that the goods listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons

Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

In view of the above, it is plain that applicant's goods and those of the cited registrant herein are inextricably related, since the former would be purchased and used exclusively by current and prospective students, including teenagers and young adults, interested in taking and/or preparing for the latter. Thus, because the respective goods are so closely related, confusion as to the source or sponsorship thereof would be likely to occur if such products were to be marketed under the same or substantially similar marks.

Turning, therefore, to consideration of the marks at issue, applicant argues that, as indicated in the declaration of record from its president, Douglas J. Paul, there are a number of competing products in the marketplace and that "students shopping for materials to help them prepare for the SAT will become aware of several competing products," or at least a few of them, "from which they may make their selection."⁴ According

⁴ In particular, Dr. Paul declares that he "is aware of several competitors of applicant which produce test-taking preparation materials directed to students enrolled to take the SAT and is aware that the names of many of these materials as used in commerce refer directly to the SAT"; that "such names" include, for example, "ARCO Preparation for the SAT with Sample PSAT," "ARCO's Cram Course for the SAT," "Gruber's Inside Strategies for the SAT," "How to Beat the SAT and All Standardized Multiple Choice Tests," "Peterson's SAT Success," "SAT Cram Course" and "SAT Supercourse," as well as the following

to applicant, "[i]n that marketplace, which [concededly] attracts students preparing to take the SAT,"

a potential purchaser who inspects a shelf of competing products (or otherwise gathers purchase-oriented information) will immediately be conditioned to realize that "SAT" in *each* of these titles shows what they have in common--that they all have to do with the SAT. It becomes obvious that the expression "SAT" in these titles cannot distinguish one competing item from the others, since *each* of them contains the expression "SAT". Thus, the "SAT" feature of applicant's mark would ... be unregistrable material Accordingly, "SAT" in applicant's mark is a weak feature, not a dominant feature.

.... As is normal for virtually any category of consumer goods, the competing items of the category are typically shelved together at retail, to facilitate location and decision by potential purchasers. In the actual commercial context in which applicant's products are marketed or will be marketed, potential purchasers are looking for competitive products, *all* of which pertain to the SAT. When potential purchasers find the category in a retail outlet, ... they will see typically that many of these competing products have the expression "SAT" in their titles. Within this real-world marketplace, "SAT" is in fact the most diluted portion of each of these marks. The other words of the marks must receive the primary focus, because they are necessarily the only features by which the marks may be distinguished from one another. Said more

computer software titles: "Cliff's Studyware for the SAT I," "Your Personal Trainer for the SAT," "The Princeton Review: Inside the SAT & PSAT" and "Score Builder for the SAT & PSAT"; and that "each of the items referred to above has been openly available for purchase and use by students enrolled to take the SAT."

fully, the expression "INSIDE THE" is what distinguishes applicant's mark from marks ... for various competing products which also pertain to the "SAT".

By this analysis--or, rather, by this observation of the commercial context--it is seen that "INSIDE THE" forms the distinguishing commercial impression and therefore is the dominant portion of applicant's mark ... rather than "SAT".

Requesting, in addition, that the Board take judicial notice that, as shown by the excerpt accompanying applicant's main brief, The American Heritage Dictionary of the English Language (1981) at 1153 defines the term "SAT" in relevant part as "2. Scholastic Aptitude Test" and lists the term "S.A.T." as likewise meaning "Scholastic Aptitude Test,"⁵ applicant further asserts that:

[T]o readers of the English language whose impression of "SAT" is the same as the dictionary's definition of SAT, applicant's mark "INSIDE THE SAT" would give the commercial impression of "inside the Scholastic Aptitude Test." This is the intended commercial impression. It is believed that applicant could freely use [and register] as a mark "Inside the Scholastic Aptitude Test" ...[,] registration of the mark "SAT" notwithstanding. Moreover, if applicant

⁵ Although the submission of such evidence is technically untimely under Trademark Rule 2.142(d), we have nevertheless considered the definitions offered by applicant inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

would find this expression to be too long for good marketing, it ought to be able to use the dictionary equivalent of the lengthiest portion and, thus, to use [and register] the mark "INSIDE THE SAT."

Applicant also argues that "its use of 'SAT' within its mark ... is descriptive or collateral use." Specifically, while insisting that it is not engaging in a collateral attack on the validity of the cited registration, applicant maintains that:

The expression "SAT" may be used in a source-indicating sense by the owner of the mark but, nevertheless, may also correctly be used by anyone in its dictionary-recognized descriptive sense to refer to a test popularly known by its generic name "Scholastic Aptitude Test". An example of that latter use is found within applicant's mark INSIDE THE SAT.

It is normal for individuals to be called upon every day to resolve double entendres, and experience has taught them to do so by reference to the context. [P]otential purchasers would recognize that applicant's use of "SAT"--in the verbal context of "INSIDE THE SAT" and in the commercial context of the competing and similarly structured titles in its unique marketplace--is descriptive of a certain broadly required entrance examination called the Scholastic Aptitude Test. The use of "SAT" in this context could not be construed as being a source-indicator, that is, as being the means of distinguishing applicant's products from those of other sources competing in that marketplace--for many of the other sources use the same acronym "SAT" within their multiword titles for the same descriptive purpose.

In view thereof, applicant urges that, in the context in which it intends to market its products under its mark, confusion with registrant's mark for printed tests and test booklets is not likely since the respective marks present different overall commercial impressions.

We agree with the Examining Attorney, however, that when marketed under the marks "INSIDE THE SAT" and "SAT," confusion as to the origin or affiliation of the respective goods would be likely. Although the Examining Attorney has not specifically addressed applicant's "descriptiveness" argument, other than to correctly note that the validity of the cited registration cannot be collaterally attacked in this appeal by alleging that the mark is merely descriptive in a certain context,⁶ the fallacy in applicant's position lies in its insistence that third-party uses of the term "SAT" are descriptive usages rather than references to registrant's "SAT" mark. Nowhere in the declaration of applicant's president is there any indication whether or not the third-party uses of the term "SAT" of which applicant is aware are pursuant to a license from registrant as the owner of the "SAT" mark. Moreover, in

⁶ See, e.g., *In re C. F. Hathaway Co.*, 190 USPQ 343, 345 (TTAB 1976); *In re American Heritage Publishing Co., Inc.*, 172 USPQ 247, 248 (TTAB 1971), *aff'd without pub. op.*, 487 F.2d 1407, 180 USPQ 142 (CCPA 1973); and 3 J. McCarthy, McCarthy on Trademarks & Unfair Competition §23.80 (4th ed. 1996). Instead, a cancellation proceeding would be the proper vehicle for raising such a contention.

light of the prima facie presumptions afforded the cited registration under Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), it must be assumed, inter alia, that "SAT" is a valid mark for registrant's "printed tests and test booklets" and that registrant has the exclusive right to the use of such mark in connection with those goods. Consequently, what applicant contends is "descriptive" use of "SAT" must be considered as a clear reference, by applicant and the third-parties with which it competes in the marketing of test preparation materials, to registrant's goods by their brand name. Registrant's goods, in other words, are not just any scholastic aptitude tests, but rather are the ones identified and distinguished by registrant's "SAT" mark.

When thus viewed in the proper framework, it is readily apparent that, as contended by the Examining Attorney, the dominant and distinguishing portion of applicant's "INSIDE THE SAT" mark is the term "SAT," which not coincidentally happens to be registrant's mark since it is registrant's "SAT" tests for which applicant's goods are meant to serve as preparation materials. The fact that applicant has voluntarily disclaimed the term "SAT" does not, as the Examining Attorney correctly points out, remove such matter from consideration in determining whether there is a likelihood of confusion. See, e.g., In re National Data Corp., 753 F.2d 1056, 224 USPQ 749,

751 (Fed. Cir. 1985) [technicality of a disclaimer in an application to register a mark has no legal effect on the issue of likelihood of confusion since the public is unaware of what words have been disclaimed during prosecution; "tactical strategy" of a voluntary disclaimer "cannot affect the scope of protection to which *another's* mark is entitled"].

It is well settled that an applicant may not appropriate another's entire mark and avoid likelihood of confusion by merely adding subordinate matter to it. See, e.g., *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986); and *R.J. Reynolds Tobacco Co. v. R. Seeling & Hille*, 201 USPQ 856, 860 (TTAB 1978). Here, applicant has simply taken registrant's mark "SAT" and added thereto the subordinate matter "INSIDE THE," which as the Examining Attorney notes suggests that purchasers of applicant's test preparation materials "will gain an inside knowledge of the SAT," including intricate information which could come only from the producer of the "SAT" test itself. Thus, while there are obvious differences between applicant's "INSIDE THE SAT" mark and registrant's "SAT" mark in, for instance, sound and appearance, such differences do not serve to distinguish the marks since, when considered in their entirety, the marks are substantially similar in overall commercial impression due to the dominant presence of the source-signifying term "SAT" in applicant's mark.

Applicant nevertheless urges, in reply, that confusion is not likely in view of the sophistication of the purchasers of the respective goods. However, due to their relatively young age and inexperience, it is doubtful that high school students, who would constitute the principal purchasers and/or users of applicant's test preparation materials since taking registrant's "SAT" test is typically a part of the requirements for those seeking college admission, would be careful and discriminating consumers who are knowledgeable about competing study aids for such an examination. Still, even among those students (or their parents) who, because of the importance of scoring well on registrant's "SAT" test as enhancing the probability that they will receive admission to the college of their choice, may exercise care and deliberation in their selection of test preparation materials, such discrimination "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983).

Accordingly, we conclude that purchasers and potential customers, who are familiar or acquainted with registrant's "SAT" mark for printed tests and test booklets, would be likely

to believe, upon encountering applicant's substantially similar "INSIDE THE SAT" mark for its videotapes, video discs, computer programs and CD-ROMS in the field of educational test preparation for taking scholastic aptitude tests and scholastic assessment tests, that such closely related goods emanate from, or are sponsored by or associated with, the same source.⁷

Decision: The refusal under Section 2(d) is affirmed.

R. L. Simms

G. D. Hohein

C. M. Bottorff
Administrative Trademark

Judges,

⁷ We note that applicant has previously sought registration for the same mark for goods which, on their face, were even closer to those in the cited registration than those in this appeal, and that the Board affirmed the refusal to register applicant's mark on the basis of the cited registration. Specifically, as acknowledged in the briefs by both applicant and the Examining Attorney, applicant filed a companion application, Ser. No. 75/057,816, on February 14, 1996 seeking registration of the mark "INSIDE THE SAT" for "kits comprising books, workbooks, worksheets, charts, diagrams, videotapes, video disks, computer programs, CD-ROMs, practice tests, teachers' and presenters' manuals, or kits comprising practice tests and at least one of the aforesaid goods, all in the field of educational test preparation; books, workbooks, worksheets, charts, diagrams, practice tests, teachers' and presenters' manuals, all in the field of educational test preparation" and for "educational services, namely, conducting classes, workshops, and tutorials in the field of educational test preparation."

Ser. No. 75/202,389

Board

Trademark Trial and Appeal